

Application No. 10/820,385
Response dated: January 15, 2009
Reply to Non-Final Office Action of: October 15, 2008

Amendments to the Drawings:

The attached sheets of drawings include changes to FIG. 2. The changes reflect changes to step 410 to read “connecting patient terminal to hospital server”.

Attachment: Replacement Sheet

REMARKS

The above amendments are made in response to the outstanding Non-final Office Action dated October 15, 2008. The Examiner's reconsideration is respectfully requested in view of the above amendments and the following remarks

Claims 1, 2, 7, 8, 10, 13, 14 and 15 have been amended to more clearly define the claimed invention. Claims 8, 10, 13 and 14 have been amended to be in independent form and to include the elements of independent claim 1 from which they previously depended. Support for the amendments to the claims may be found throughout the specification as filed, specifically support for the amendments to independent claim 1 may be found in FIG. 1 and page 6, lines 3-10 of the specification, support for the amendments to claims 8, 10, 13 and 14 may be found in claim 1 as originally filed, and support for the amendment to claim 15 may be found in claim 14 as originally filed. No new matter has been introduced by these amendments.

The drawings of this application have been amended to more properly disclose Applicant's invention. Applicants have amended FIG. 2 to better match the detailed description. Support for the amendments may be found throughout the specification and drawings as filed, specifically in page 7, lines 5-6 of the application as filed. No new matter has been introduced by these amendments.

Claims 1-15 are pending in the present application.

Claim for Priority

Applicants note that the Examiner has not acknowledged receipt of the certified copies of the priority document filed on April 7, 2004. Applicants respectfully request confirmation of the receipt of the same.

Claim Objections

In the present Office Action, the Examiner has objected to claims 2 and 8-15. The Examiner specifically states that claim 2 should be amended to conclude with a period ("."). Claim 2 has been amended as suggested by the Examiner.

Regarding claims 8-15, the Examiner states (on page 2 of the Office Action) that these claims are in improper dependent form, as the claims would allegedly fail the infringement test.

Applicants do not agree with the Examiner that claims 8-15 would fail the infringement test, since those claims depend from claim 1, and thereby include all of the limitations of claim 1. However, in the interest of furthering prosecution, Applicants have amended claims 8, 10, 13 and 14 to be in independent form and explicitly incorporate the limitations of claim 1 in each of the amended claims, thereby ensuring that claims 8-15 further limit the scope of the independent claims from which they depend and thus passing the infringement test as laid out by the Examiner.

Applicants respectfully request that in light of the present amendments the objections to claims 2 and 8-15 be withdrawn.

Claim Rejections Under 35 U.S.C. §112

Claims 1-15 stands rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (See pages 3-5 of the present Office Action).

Specifically, the Examiner states that claims 1, 4, 8, 9, 10, 13 and 14 use the term “patient terminal”, which the Examiner further states appears to mean a portable card or other portable device, but that “patient terminal” has not been clearly redefined in the specification to mean something other than “a combination of a keyboard and out put device...” (i.e., has not been clearly redefined to mean a portable card or device.)

In this regard, Applicants respectfully direct the Examiner’s attention to page 5, lines 30-32, page 7, lines 5, 6 and 18, and page 8, lines 1-11 of the specification as filed which describe the features and usage of the personal terminal. Specifically, the limitation “patient terminal” may refer to any component which may hold a medical care code list database 110, a non-identification (ID) database 120, an insurance database 130, and an ID storage unit 140, and which may be connected and disconnected to a hospital server. While the Examiner provides several examples of an embodiment of the patient terminal, e.g., a portable card or portable device, the present invention is not limited thereto, and may include the Examiner’s alternative definition of a combination keyboard and output device.

The Examiner has also rejected claims 1-12 under 35 U.S.C. § 112, second paragraph, for reciting various forms of data (ID data, non-ID data, medical care code data, etc.) and their databases but allegedly not clearly defining differences between the different data. Applicants

have amended the various forms of data recited in the claims to further differentiate between them.

Applicants have amended claim 1 to recite "...ID data including personal information about the patient and non-ID data including non-personal information about the patient ..." as described at page 6, lines 3-10 of the application.

Claim 7 has been rejected under 35 U.S.C. § 112, second paragraph, for using the terms "such as" and "etc." These terms have been removed from claim 7.

Claim 7 has also been rejected under 35 U.S.C. § 112, second paragraph, as the limitation "...prepared by using..." is allegedly unclear as to what device in the system does the preparing or how it is prepared. This limitation has been deleted from claim 7.

Claim 14 has been rejected under 35 U.S.C. § 112, second paragraph, as the limitation "care details required for demanding a medical insurance money" is allegedly unclear as to what the details required or may include. Claim 14 has been amended to recite: "a) notifying an insurance institution of a demand for medical insurance money based on the medical care codes and care details".

Claim 14 has also been rejected under 35 U.S.C. § 112, second paragraph for using the term "premium", which the Examiner states appears to mean a payment by an insurer to an entity, but which is generally accepted to mean money paid to insurance companies. The Examiner further states that the specification does not clearly redefine the term. The term "premium" has been amended to "payment" in claim 14.

Claim 14 has also been rejected under 35 U.S.C. § 112, second paragraph, as the limitation "insurance money details" is allegedly unclear as to what these details include. Claim 14 has been amended to recite that the insurance money details are "based on at least one of the medical care codes and the care data of the patient".

Claim 15 has also been rejected under 35 U.S.C. § 112, second paragraph, as the limitation "when details associated with insurance to be notified" is allegedly unclear as to what the details include. Claim 15 has been amended to recite that the details are "the insurance money details" (of claim 14).

Applicants therefore respectfully request the Examiner to reconsider the amended claims and withdraw the rejection of claims 1-15.

Claim Rejections Under 35 U.S.C. §103

In order for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143.

Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levensgood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In re Skill*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Claims 1-15

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram, et al. (U.S. Patent No. 5,499,293; hereinafter, "Behram") in view of Heinze, et al. in further view of Heinze, et al. (U.S. Patent No. 6,915,254; hereinafter, "Heinze").

Claims 2 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Behram in view of Heinze, in further view of Koo, et al. (U.S. Patent No. 6,874,085; hereinafter, "Koo").

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram, in view of Heinze in further view of Iverson, et al. (U.S. Patent No. 7,158,979; hereinafter, "Iverson").

Claims 4, 14 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Behram in view of Heinze, in further view of Wood, et al. (U.S. Patent No. 6,820,058; hereinafter, "Wood").

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram, in view of Heinze in further view of Wood in further view of Iverson.

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram in view of Heinze in further view of Teshima, et al. (U.S. Patent No. 6,272,470; hereinafter, "Teshima").

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram, in view of Heinze in further view of Teshima in further view of Iverson.

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram, et al. in view of Heinze in further view of Teshima, et al. in view of Iverson in further view of Mita, et al. (U.S. Patent Application Publication No. 2002/0035485; hereinafter, "Mita").

Claims 10 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Behram in view of Heinze in further view of Mita in further view Califano, et al. (U.S. Patent Application Publication No. 2003/0033168; hereinafter, "Califano").

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram in view of Heinze in further view of Mita in further view Califano in further view of Iverson.

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Behram in view of Heinze in further view of Eberhardt, et al. (U.S. Patent No. 5,659,741; hereinafter, "Eberhardt").

Specifically, the Examiner states that Behram teaches all elements of claim 1 except *the generation of a medical care codes or their storage*, which the Examiner further states is taught by Heinze, primarily at columns 4, 5 and 7. In addition, the Examiner states that neither Behram nor Heinze teach storage of the care codes in the patient terminal, which the Examiner further states would have been obvious to one of ordinary skill in the art at the time of the invention.

Applicants respectfully note that Behram teaches a device which stored compressed and encrypted patient medical data on a passive storage media (e.g., a "SmartCard"). See, e.g., Abstract, column 5, lines 23-35 column 7, lines 4-46, and FIGS. 2 & 4-6.

Heinze, on the other hand, teaches a system of automatically assigning medical codes to medical procedures using natural language computer processing techniques. See, e.g., column 1, lines 12-15, column 2, lines 30-39 and FIGS. 1, 2 & 8.

Applicants respectfully disagree with the Examiner's assertion, on page 6 of the Office action, that Behram teaches or suggests the non-ID storage unit of the patient terminal as disclosed and claimed in the present invention. Specifically, Behram does not disclose, teach or suggest: **a non-ID storage unit provided in the patient terminal separately from the ID storage unit, the non-ID storage unit storing the non-ID data of the patient** as claimed in independent claim 1, and similarly claimed in newly independent claims 8, 10, 13 and 14.

The device of Behram stores all patient data except the patient name, which is simply excluded from storage (not stored separately in the card) as shown in FIG. 4 and described at column 7, lines 11-24. In contrast, and in accordance with the present invention, the patient terminal 100 (FIG. 1) of the present invention stores both identifying information and non-identifying information in separate storage means therein, i.e., the ID storage 140 and the Non-ID storage 120, respectively.

Furthermore, Heinze fails to cure the above-noted deficiencies of Behram with respect to the independent claims. Specifically, Heinze does not disclose, teach or suggest: **a non-ID storage unit provided in the patient terminal separately from the ID storage unit, the non-ID storage unit storing the non-ID data of the patient** as claimed in independent claim 1, and similarly claimed in newly independent claims 8, 10, 13 and 14.

In addition, with respect to claims 2-15, the alleged teachings, or any other disclosure, of Koo, Iverson, Wood, Teshima, Mita, Califano and Eberhardt, alone or in combination, fail to cure the above-noted deficiencies of Behram with respect to independent claim 1, the elements of which have also been incorporated into newly independent claims 8, 10, 13 and 14.

Applicants submit that Behram, Heinze, Koo, Iverson, Wood, Teshima, Mita, Califano and Eberhardt, either alone or in combination with the knowledge available to one of ordinary skill in the art, do not render obvious the subject matter of independent claim 1. Claims 2-7 depend from claim 1, and thus include the allowable elements of claim 1. Claim 9 depends from claim 8, which has been amended to include the limitations of claim 1, and thus includes the allowable elements of claim 8. Claims 11 and 12 depend from claim 10, which has been amended to include the limitations of claim 1, and thus include the allowable elements of claim

10. Claim 15 depends from claim 14, which has been amended to include the limitations of claim 1, and thus includes the allowable elements of claim 14. It is thus believed that the dependent claims are patentable over the cited references for at least the reasons given above for independent claim 1.

Accordingly, it is respectfully submitted that the claimed invention is allowable over the cited references. The Examiner's reconsideration and withdrawal of the rejection of claims 1-15, and the subsequent allowance thereof, is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Reconsideration and subsequent allowance of this application are courteously requested.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Applicants hereby petition for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply

The Examiner is invited to contact Applicant's Attorneys at the below-listed telephone number with any questions or comments regarding this Response or otherwise concerning the present application.

Respectfully submitted,

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